

Remarks:

Responsive to the Official Action mailed May October 7, 2003 Applicant respectfully requests reconsideration and allowance of claims 1-2 and 4-14 in view of the above amendments and the following remarks.

The Examiner has rejected claims 1-14 under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The Examiner has taken the position that the claims subject matter which that was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to *make* and/or use the invention. Specifically, the Examiner states that while Applicant makes the assertion that the swab of the present application performs a particular function and that the prior art does not, there is no disclosure of the particular materials that make up the present swab that enable it to function as described and that would structurally define over the prior art. The Examiner states that, for example, while the swab of the present application may include a cleaning tip formed from polyester (paragraph 0023, line 3), the admitted prior art also has a static-dissipative handle and a polyester cleaning tip (paragraph 0005) and there is no mention of what is different about the swab of the present application and that of the prior art (which also includes the prior art made of record by the examiner in the prior office action). The Examiner's position is that if there is a structural difference between the swab of the present application and that of the prior art which constitutes an improvement over the prior art and which enables it to function as described, there is no mention of it.

Next, the Examiner has rejected claims 1-14 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner states that claims are indefinite for much the same reasons set forth with respect to the 112, 1st paragraph rejection. The Examiner states that, in addition, claims that merely set forth physical characteristics desired in an article, and that do not set forth specific compositions which would meet such characteristics are vague, indefinite and functional, citing Ex parte Slob (BPAI) 157 USPQ

172. The Examiner believes that this matter is complicated in the present instance in that the materials of the claimed swab that would allegedly be the improvement or the structure that might define over the structure of the prior art are not disclosed with any specificity to define over the structure of the prior art.

The present invention is directed to an electro-static dissipating swab that has a handle formed from an electro-static dissipative material and a cleaning tip that is formed from an electro-static dissipative material. The cleaning tip material is a sealed, electro-statically conductive material. The cleaning tip is secured to the handle at a cleaning head end.

The swab, in a dry state, dissipates a static electrical charge from a charge plate having a 20 picofarad capacitance at a charge of 1000 volts to a charge of less than 10 volts in less than about 500 milliseconds and in a wetted state dissipates a static electrical charge from a charge plate having a 20 picofarad capacitance at a charge of 1000 volts to a charge of less than 10 volts in less than about 100 milliseconds.

Examples of materials that meet these claim limitations include conductive foam, micro-porous foam, polyester, sealed conductive fabric and wrapped conductive fabric. Applicant submits that these exemplars are sufficiently specific to enable one of skill in the art to *make* and/or use the invention. In fact, it is applicant's position that the claims include both structural as well as functional limitations and that the specification discloses both structure and materials that enable one to make the present swab to function as described. Thus, it is applicant's position that the rejections under Section 112, first and second paragraphs are improper and should be withdrawn.

The Examiner has next rejected claims 1,5 and 6 under 35 U.S.C. 103(a) as unpatentable over Pisacane et al., U.S. Patent No. 5,460,655 in view of the admitted prior art of paragraph 0005. The Examiner has taken the position that the patent to Pisacane (discussed in detail in earlier responses) discloses a swab having a handle (of polypropylene) on which is secured an open-cell, hydrophilic, static-dissipative, polyurethane foam. The Examiner concedes that patent to Pisacane fails to specific whether the polypropylene handle is "static-dissipative",

but states that because it is known in the art (per the specification) that a static-dissipative swab can be comprised of a static-dissipative handle mounting a static-dissipative tip, it would have been obvious to have modified the swab of Pisacane to further prevent the forming of a static charge on the surface being cleaned. The Examiner states further that a static-dissipative foam would, to function as such, be "conductive" as in claim 5 and that with regard to claim 6, one of ordinary skill would deem it obvious to utilize dissipative polyurethane foams of any available pore size based on the intended surface to be cleaned.

It is applicant's position that on the one hand the Examiner states (with respect to the section 112 rejections) that Applicant has not enabled one skilled in the art to make and use the invention while, on the other hand, the Examiner concludes the claimed invention would have been obvious to one of skill in the art with the patent to Pisacane in hand. Applicant is confused as to the Examiner's reasoning. Specifically, it is Applicant's position that if one could not make and/or use the claimed invention from the specification how would one know what it is?

Nevertheless, it is applicant's position that not only are the Section 112 rejections improper, but that the Section 103 rejections over Pisacane are also improper. Specifically, the Examiner states in a conclusory manner that it would have been obvious to have modified the swab of Pisacane to further prevent the forming of a static charge on the surface being cleaned, but provides no teaching or suggestion to make such a statement. Without more, it is Applicant's position that this is merely a rejection made in hindsight, with the present specification in hand. And, such rejections are simply improper.

The Examiner has next rejected claim 2 under 35 U.S.C. 103(a) as unpatentable over the prior art as applied to claim 1 above, and further in view of Ito et al., U.S. Patent No. 4,741,066. The Examiner states that the patent to Pisacane discloses the use of a polymeric handle material, but fails to disclose the specific material of claim 2, and that the patent to Ito discloses the use of polybutylene terephthalate.

Applicant, however, submits that claim 2, which depends from claim 1 is allowable for

the same reasons that claim 1 is allowable over the art of record.

Next, the Examiner has rejected claims 11-14 under 35 U.S.C. 103(a) as unpatentable over the prior art as applied to claim 1 above, and further in view of Halford et al., U.S. Patent No. 4,401,130. The Examiner characterizes Halford as disclosing the foam portion being in the form of a seamless tube that is bonded or otherwise secured to a handle, and states that one of ordinary skill in the art would deem it obvious to utilize any known methods of securing a foam swab to a handle. As to the tube, it is the Examiner's position that one of ordinary skill would deem it obvious to utilize various shapes of the cleaning tip including the tube shape of Halford so that it might by better used to clean tubes.

Last, the Examiner has rejected claims 1,3, 4, and 7-10 under 35 U.S.C. 103(a) as unpatentable over Burrow et al., U.S. Patent No. 5,214,821 in view of the admitted prior art of paragraph 0005. The Examiner has taken the position that the patent to Burrow discloses a swab for cleaning electrical equipment in a cleanroom environment that includes a nylon handle and further includes a tubular knit polyester fabric spirally wound onto the handle and thermally sealed thereto. The Examiner states that the method of manufacture is not germane to the patentability of the device itself and that Applicant has defined the cleaning tip as being a knit tube of polyester, which is taught by Burrow. With regard to the material of the handle, applicant's admission in paragraph 0005 states that the use of such a material is known in the art and thus the Examiner concludes that it would have been obvious to one of ordinary skill to have modified the device of Burrow so as to reduce or eliminate the creation of static charge (especially given the disclosed use of the device of Burrow in a cleanroom).

As set forth previously by Applicant, the functional limitations, namely "wherein the swab, in a dry state, dissipates a static electrical charge from a charge plate having a 20 picofarad capacitance at a charge of 1000 volts to a charge of less than 10 volts in less than about 500 milliseconds and in a wetted state dissipates a static electrical charge from a charge plate having a 20 picofarad capacitance at a charge of 1000 volts to a charge of less than 10 volts in less than about 100 milliseconds", are (admitted) clear and purposeful limitations of the claim. However,

it is applicant's position that these limitations have not been shown in any one or more of the prior art documents (or the admitted prior art). As such, it is incumbent upon the Examiner to show these limitations in order to set forth a *prima facie* case that the claims at issue would have been obvious to one of skill in the art at the time of the invention.

With this in mind, Applicant notes that none of the references of record disclose these functional elements or characteristics of the static dissipative material. Thus, it is Applicant's position that the Examiner has not met his burden of showing that the limitation is contained in one or more of the references of record. The law has placed on the Examiner the burden to set forth a *prima facie* case of obviousness. This requires that the Examiner show: "(1) one or more references; (2) that were available to the inventor and; (3) that teach; (4) a suggestion to combine or modify the references; and (5) the combination of or modification of which would appear to be sufficient to have made the claimed invention obvious to one of ordinary skill in the art." Irah H. Donner, *Patent Prosecution, Practice and Procedure Before the U.S. Patent Office*, Ch. 7.II (2d ed. 1999).

In the present instance, the Examiner has failed to meet this burden. Specifically, the Examiner has failed to show any of the material disclosed or discussed in the prior art, and that is used to make swabs, includes the static dissipative characteristics claimed. Thus, at a minimum one of the claimed limitations is not disclosed in the art of record and as such the rejections under §103 are clearly improper and should be withdrawn.

Functional limitations alone are sufficient to distinguish a claimed invention over the prior art. *See, e.g.*, Donner, Ch. 7X, citing *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). This is not to say that the only differences between the presently claimed invention and the prior art is the claimed functional limitations. Rather, it is Applicant's position that the claimed functional limitations, without more, are sufficient to distinguish the claimed invention over the admitted prior art (discussed in the Background section of the specification), Pisacane et al., Ito et al., Halford et al. and Burrow et al., because none of these patents disclose the specific functional characteristic limitations directed the static dissipative properties of the swab.

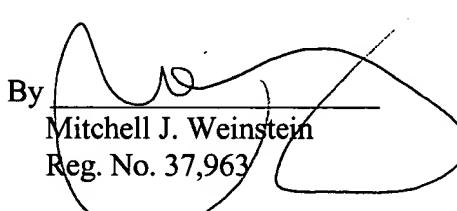
In conclusion, it is Applicant's position that the Examiner has failed to set forth the requisite elements to show a *prima facie* case of obviousness. Thus, the rejections of now pending claims 1-2 and 4-14 under §103 are improper and should be withdrawn, and the claims allowed to move on to allowance and issue. And, as such, Applicant submits that claims 1-2 and 4-14 are in fact allowable over the art of record and respectfully and earnestly solicits early indication of same.

Applicant believes that there is no fee due in connection with the present Amendment B. If, however, there is a fee due, the Commissioner is hereby authorized to charge any under-payment or credit any over-payment to Deposit Account No. 23-0920. If necessary, the present paper is to be considered any required petition.

Should the Examiner believe that a telephone interview would expedite prosecution and allowance of the present application, or address any outstanding formal issues, he is respectfully requested to contact the undersigned.

Respectfully submitted,

WELSH & KATZ, LTD.

By 
Mitchell J. Weinstein
Reg. No. 37,963

January 5, 2004

WELSH & KATZ, LTD.
120 South Riverside Plaza, 22nd Floor
Chicago, Illinois 60606
(312) 655-1500 Telephone
(312) 655-1501 Facsimile